REMARKS

By this amendment, claims 14-15 have been amended. Claims 1-15 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 14-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended to address the concerns raised in the Office Action. Applicant respectfully requests that the rejection of these claims be withdrawn and the claims allowed.

Claims 14-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Powelson et al. (US 6,940,790). This rejection is respectfully traversed.

Claim 14 recites an information recording medium comprising, *inter alia*, "multi-level data converted from binary data; and test data used in reproducing the multi-level data, wherein the test data includes combinations of data comprising same numeric series, wherein the test data and the multi-level data is usable to determine whether the test data is normal, and wherein determining whether the test data is normal comprises determining whether a distribution of the test data is within a predetermined range" (emphasis added). Claims 15 recites similar limitations. Applicant respectfully submits that Powelson et al. does not disclose these limitations.

To the contrary, Powelson et al. discloses that "[i]f the mean-squared-difference between the target and recovered data pattern is less than a maximum threshold error value, the procedure terminates successfully." Col. 7, ln. 7-10. Applicant respectfully

submits that Powelson et al. does not disclose, teach, or suggest that determining whether the test data is normal comprises determining whether a distribution of the test data is within a predetermined range, as recited in claims 14-15.

Since Powelson et al. does not disclose all the limitations of claims 14-15, claims 1 and 14-15 are not anticipated by Powelson et al. Applicant respectfully requests that the 35 U.S.C. § 102(b) rejection of claims 14-15 be withdrawn and the claims allowed.

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Powelson et al. in view of Fujita et al. (US 5,469,420). This rejection is respectfully traversed. Neither Powelson et al. nor Fujita et al., even when considered in combination, teaches or suggests all of the limitations of independent claims 1 or 13.

Claim 1 recites an information recording/reproducing apparatus comprising, *inter alia*, "a test data examining unit examining the reproduction signals of the multi-level data including the test data to determine whether the test data is normal, wherein determining whether the test data is normal comprises determining whether a distribution of the test data is within a predetermined range" (emphasis added). Claim 13 recites similar limitations. Applicant respectfully submits that Powelson et al. and Fujita et al., even when combined, fail to teach or suggest these limitations.

To the contrary, Fujita et al. teaches that the "threshold values L_{S1} and L_{S2} [are] used for detection of a reproduction signal of actual reproduction data of each sector." Col. 5, ln. 35-37 (emphasis added). The threshold values L_{S1} and L_{S2} "are calculated from distribution information of the reproduction data of the sector." Col. 5, ln. 37-38. No test data is used, only the data to be reproduced. Applicant respectfully submits that Fujita

et al. does not disclose, teach, or suggest determining whether the test data is normal comprises determining whether a distribution of the test data is within a predetermined range, as recited in claims 1 and 13. The Office Action admits at page 5 that Powelson et al. fails to disclose these limitations. Thus, Powelson et al. does not remedy the deficiencies of Fujita et al.

Furthermore, since Fujita et al. is directed toward detecting only the actual data to be reproduced (Col. 5, ln. 35-37), one skilled in the art would not look to Fujita et al. to modify Powelson et al. to reach the claimed invention. The Supreme Court recently said in *KSR Int'l Co. v. Teleflex Inc.* that "the [Graham] factors continue to define the inquiry that controls" a finding of obviousness and reiterated that a "patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." 127 S. Ct. 1727, 1734 (U.S. 2007). The Graham factors include determining the scope and content of the prior art, ascertaining differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

Applicant submits that the Office Action has not properly shown that the Applicant's claims would have been obvious by conducting an examination of the Graham factors. "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." M.P.E.P. § 2141. Instead, to show that Powelson et al. and Fujita et al. may be properly combined and that the Applicant's claims are obvious in light of these references, the Office Action merely stated that it would be obvious to combine Fujita et al. with Powelson et al. "to compensate for abnormal differences in reflection values that may result from part of the test data." Office Action at p. 5. This unsupported statement is not

an adequate substitution for an analysis of the Graham factors and does not show obviousness. As stated above, Fujita et al. does not relate to test data at all.

Since Powelson et al. and Fujita et al. do not teach or suggest all of the limitations of claims 1 and 13, claims 1 and 13 are not obvious over the cited combination. Claims 2-12 depend from independent claim 1, and are patentable at least for the reasons mentioned above, and on their own merits. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 1-13 be withdrawn and the claims allowed.

In view of the above, Applicant believes the pending application is in condition for allowance.

Dated: December 17, 2007

Respectfully submitted,

By _____

Mark J. Thronson
Registration No.: 33,082
Rachael Lea Leventhal
Registration No.: 54,266
DICKSTEIN SHAPIRO LLP
1825 Eye Street, NW
Washington, DC 20006-5403
(202) 420-2200
Attorneys for Applicant